

REMARKS/ARGUMENTS

In response to the Final Office Action mailed August 1, 2003, Applicants propose to amend their application and request reconsideration in view of the proposed amendments and the following remarks. In this amendment, Claims 1 and 9 are proposed to be amended, Claims 18-31 were previously cancelled without prejudice and no claims have been added so that Claims 1-17 are currently pending. No new matter has been introduced.

Claim 1 was objected to for a minor informality. Accordingly, Applicants have amended the claim to correct the typographical error.

Claims 1-14, 16 and 17 were rejected as being unpatentable over WO 97/33534 to Globerman et al. (Globerman) in view of U.S. Patent No. 5,632,771 to Boatman et al. (Boatman). Claim 15 was rejected as being unpatentable over Globerman in view of Boatman and further in view of U.S. Patent No. 6,022,374 to Imran (Imran). These rejections are respectfully traversed.

Globerman discloses a stent having radiopaque stent markers. The markers are secured in position in holes in the stent structure. The markers comprise short rods made from a radiopaque material. Each marker is compressed into an opening in the stent. In a slightly different approach, the marker has a flair or cone

like structure for more secure placement. In yet another variation, the marker has chamfered edges. The markers may be round or oval.

Boatman discloses a stent having radiopaque markers. The stent comprises eyelets for positioning the markers therein. The markers are heated such that they are melted into place. In alternate methods, the markers may be crimped into the eyelets.

Imran discloses a stent with radiopaque markers. The markers are built into the framework of the stent in such a manner as not to interfere with stent operation.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d, 488, 20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The present invention as claimed in amended independent Claims 1 and 8 claims devices comprising markers. The markers include a marker housing and a marker insert. The marker housing and the marker insert each have a radius of curvature equal to the radius of curvature of the medical device. In addition, the marker housing has a conical taper.

The references, whether taken alone or in combination, fail to disclose or even remotely suggest markers where the housing and insert have a curved surface to match that of the device to which they are attached. In addition, the references fail to disclose a housing having a conical taper.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355 (Fed.Cir.1998). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight." In re Demiczak, 175 F.3d 994, 999 (Fed.Cir.1999). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075 (Fed.Cir.1988).

- It is respectfully submitted that there is simply no motivation to combine the references cited. For the reasons given, reconsideration and withdrawal of the rejections are respectfully requested.

Applicants would be willing to interview the present case if the Examiner so desires.

The amendment raises no new issues and places the application in favor for allowance. Therefore, entry is proper and earnestly solicited.

Respectfully submitted,



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